Remarks:

Amendments to the claims:

Claims 1-19 are pending in this application. By this Amendment, claim 1 is amended.

No new matter is added to the application by this Amendment. The features added to claim 1 find support in the Examples of the present application and within the specification, as originally filed, at, for example, paragraphs [0006], [0014] and [0015] in U.S. Patent Publication No. 2008/0245994 for the present application (hereinafter "the 994 publication").

Entry of the amendments is proper under 37 CFR §1.116 since the amendments: (a) place the application in condition for allowance for the reasons discussed herein; (b) do not raise any new issue requiring further search and/or consideration as the amendments amplify issues previously discussed throughout prosecution; and (c) place the application in better form for appeal, should an appeal be necessary. The amendments are necessary and were not earlier presented because they are made in response to arguments raised in the final rejection. Entry of the amendments and reconsideration of the application are thus respectfully requested.

Regarding the rejection of claims 1 and 3-16 under 35 USC 102(b) as allegedly being anticipated by or, in the alternative, under 35 USC 103(a) as allegedly unpatentable over U.S. Patent No. 5,360,567 to Fry et al. (hereinafter "Fry"):

Applicant traverses the Examiner's rejection of claims 1 and 3-16 as allegedly being anticipated by or unpatentable over Fry.

Prior to discussing the relative merits of the Examiner's rejection, Applicant points out that unpatentability based on "anticipation" type rejection under 35 USC 102(b) requires that the invention is not in fact new. See *Hoover Group, Inc. v. Custom Metalcraft, Inc.*, 66 F.3d 299, 302, 36 USPQ2d 1101, 1103 (Fed. Cir. 1995) ("lack of novelty (often called 'anticipation') requires that the same invention, including each element and limitation of

the claims, was known or used by others before it was invented by the patentee"). Anticipation requires that a *single reference* [emphasis added] describe the claimed invention with sufficient precision and detail to establish that the subject matter existed in the prior art. See, *In re Spada*, 911 F.2d 705, 708, 15 USPQ2d 1655, 1657 (Fed. Cir. 1990).

The principle of "inherency," in the law of anticipation, requires that any information missing from the reference would nonetheless be known to be present in the subject matter of the reference, when viewed by persons experienced in the field of the invention. However, "anticipation by inherent disclosure is appropriate only when the reference discloses prior art that must necessarily include the unstated limitation, [or the reference] cannot inherently anticipate the claims." *Transclean Corp. v. Bridgewood Servs., Inc.*, 290 F.3d 1364, 1373 [62 USPQ2d 1865] (Fed. Cir. 2002); *Hitzeman v. Rutter*, 243 F.3d 1345, 1355 [58 USPQ2d 1161] (Fed. Cir. 2001) ("consistent with the law of anticipation, an inherent property must necessarily be present in the invention described by the count, and it must be so recognized by persons of ordinary skill in the art"); *In re Robertson*, 169 F.3d 743, 745 [49 USPQ2d 1949] (Fed. Cir. 1999) (that a feature in the prior art reference "could" operate as claimed does not establish inherency).

Thus when a claim limitation is not explicitly set forth in a reference, evidence "must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill." *Continental Can Co.*, 948 F.2d at 1268. It is not sufficient if a material element or limitation is "merely probably or possibly present" in the prior art. *Trintec Indus., Inc. v. Top-U.S.A. Corp.*, 295 F.3d 1292, 1295 [63 USPQ2d 1597] (Fed. Cir. 2002). See also, *W.L. Gore v. Garlock, Inc.*, 721 F.2d at 1554 (Fed. Cir. 1983) (anticipation "cannot be predicated on mere conjecture respecting the characteristics of products that might result from the practice of processes disclosed in references"); *In re Oelrich*, 666 F.2d 578, 581 [212 USPQ 323] (CCPA 1982) (to anticipate, the asserted inherent function must be present in the prior art).

The undersigned also reminds the Examiner that the determination of obviousness under § 103(a) requires consideration of the factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1 [148 USPQ 459] (1966): (1) the scope and content of the prior art; (2) the differences between the claims and the prior art; (3) the level of ordinary skill in the pertinent art; and (4) secondary considerations, if any, of nonobviousness. *McNeil-PPC, Inc. v. L. Perrigo Co.*, 337 F.3d 1362, 1368, 67 USPQ2d 1649, 1653 (Fed. Cir. 2003). There must be some suggestion, teaching, or motivation arising from what the prior art would have taught a person of ordinary skill in the field of the invention to make the proposed changes to the reference. *In re Fine*, 837 F.2d 1071, 1075, 5 USPQ2d 1596, 1600 (Fed. Cir. 1988). But see also *KSR International Co. v. Teleflex Inc.*, 82 USPQ2D 1385 (U.S. 2007).

A methodology for the analysis of obviousness was set out in *In re Kotzab*, 217 F.3d 1365, 1369-70, 55 USPQ2d 1313, 1316-17 (Fed. Cir. 2000) A critical step in analyzing the patentability of claims pursuant to section 103(a) is casting the mind back to the time of invention, to consider the thinking of one of ordinary skill in the art, guided only by the prior art references and the then-accepted wisdom in the field. Close adherence to this methodology is especially important in cases where the very ease with which the invention can be understood may prompt one "to fall victim to the insidious effect of a hindsight syndrome wherein that which only the invention taught is used against its teacher."

It must also be shown that one having ordinary skill in the art would reasonably have expected any proposed changes to a prior art reference would have been successful. *Amgen, Inc. v. Chugai Pharmaceutical Co.*, 927 F.2d 1200, 1207, 18 USPQ2d 1016, 1022 (Fed. Cir. 1991); In re O'Farrell, 853 F.2d 894, 903-04, 7 USPQ2d 1673, 1681 (Fed. Cir. 1988); *In re Clinton*, 527 F.2d 1226, 1228, 188 USPQ 365, 367 (CCPA 1976). "Both the suggestion and the expectation of success must be founded in the prior art, not in the applicant's disclosure." *In re Dow Chem. Co.*, 837 F.2d 469, 473, 5 USPQ2d 1529, 1531 (Fed. Cir. 1988).

The Patent Office acknowledges that Fry does not expressly disclose that the tablet has hardness of at least 175N. The Patent Office allegedly determines that the tablet of Fry also has hardness of at least 175N because Fry allegedly discloses identical or substantially identical composition as that set forth by Applicant which would allegedly possess the same hardness as claimed. The Patent Office alleges that even if Fry does not anticipate the claims, the claims would have allegedly been obvious in view of the teachings of Fry because it would have been obvious that the tablets of Fry would possess a similar hardness as claimed since they are made of the identical or substantially identical composition. Applicant respectfully disagrees with the allegations by the Patent Office.

Nowhere does Fry teach or suggest a compressed water-softening composition comprising at least one water-softening active comprising sodium citrate which is present in an amount of at least 42% by weight of the composition and a blend of disintegrating agents comprising a cross linked polyplasdone, a water swellable cellulose and, optionally, a water soluble salt, wherein the compressed water-softening composition has hardness of at least 175N, as required by amended claim 1.

Sodium citrate particulates are highly crystalline such that in the compression process the particulates do not allow themselves to be compressed. In contrast, inorganic particulates have a low level of crystallinity or in other words contain crystalline particles which are considerable smaller than the overall particle size of the granulate. As a result, inorganic particulates comprise a compressible matrix of inorganic material. Forming a water softening tablet from inorganic particulates is relatively easy because particulates being compressible in the compression process have a deformable nature which means that the inorganic particulates display a high level of adherence. Conversely, a tablet that contains a high proportion of sodium citrate is difficult to produce because the sodium citrate is not compressible.

Applicant discovered that producing the presently claimed compressed water-softening composition having such high amount of non-compressible sodium citrate and the claimed blend of disintegrating agents is achievable with a low level of compression and results in a table having hardness of at least 175N as evidenced by the examples of the present application. The present examples illustrate novel and non-obvious compositions having (a) citrate in the amounts of 60.5, 46.0 and 57.6% by weight and (b) polyplasdone and cellulose in the amounts of 9.0, 9.5, and 9.1% by weight, respectively, that were pressed at between 50 and 80N and had hardness measured at between 180 and 260N and friability of around 4% (see paragraph [0047] of the 994 publication). Nowhere does Fry teach or suggest preparation of a compressed water-softening composition having at least 42% by weight sodium citrate and the claimed blend of disintegrating agents and exhibiting the advantageous properties of high (but not overly high) level of hardness and a low level of friability as shown in the examples of the present invention.

Because the features of independent claim 1 are neither taught nor suggested by Fry, Fry cannot anticipate, and would not have rendered obvious, the features specifically defined in claim 1 and its dependent claims.

For at least these reasons, claims 1 and 3-16 are patentably distinct from and/or non-obvious in view of Fry. Reconsideration and withdrawal of the rejections of the claims under 35 USC 102(b) are respectfully requested.

Regarding the rejection of claims 1-7 and 14-19 under 35 USC 102(b) as allegedly being anticipated by or, in the alternative, under 35 USC 103(a) as allegedly being unpatentable in view WO 00/04122 to Holderbaum et al. (hereinafter "Holderbaum"):
Applicant traverses the Examiner's rejection of claims 1-7 and 14-19 as allegedly being anticipated by or unpatentable over Holderbaum.

The Patent Office acknowledges that Holderbaum does not expressly disclose that the tablet has hardness of at least 175N. The Patent Office allegedly determines that the tablet of Holderbaum also has hardness of at least 175N because Holderbaum allegedly

discloses identical or substantially identical composition as that set forth by Applicant which would allegedly require the same hardness as claimed. The Patent Office alleges that even if Holderbaum does not anticipate the claims, the claims would have allegedly been obvious in view of the teachings of Holderbaum because it would have been obvious that the tablets of Holderbaum would possess a similar hardness as claimed since they are made of the identical or substantially identical composition. Applicant respectfully disagrees with the allegations by the Patent Office.

Holderbaum fails to teach or suggest a compressed water-softening composition comprising at least one water-softening active comprising sodium citrate which is present in an amount of at least 42% by weight of the composition and a blend of disintegrating agents comprising a cross linked polyplasdone, a water swellable cellulose and, optionally, a water soluble salt, wherein the compressed water-softening composition has hardness of at least 175N, as required by amended claim 1.

Similar to Fry, Holderbaum does not teach or suggest preparation of a compressed water-softening composition having at least 42% by weight sodium citrate and the claimed blend of disintegrating agents and exhibiting the advantageous properties of high (but not overly high) level of hardness and a low level of friability as the present invention.

Because the features of independent claim 1 are neither taught nor suggested by Holderbaum, Holderbaum cannot anticipate, and would not have rendered obvious, the features specifically defined in claim 1 and its dependent claims.

For at least these reasons, claims 1-7 and 14-19 are patentably distinct from and/or non-obvious in view of Holderbaum. Reconsideration and withdrawal of the rejections of the claims under 35 USC 102(b) are respectfully requested.

Regarding the rejection of claims 1-19 under 35 USC 103(a) as allegedly being unpatentable over Holderbaum in view of Fry:

Applicant traverses the Examiner's rejection of claims 1-19 as allegedly being unpatentable over Holderbaum and Fry.

The Patent Office acknowledges that Holderbaum does not expressly disclose that the tablet has hardness of at least 175N. The Patent Office introduces Fry as allegedly remedying the deficiencies of Holderbaum by teaching that compaction pressure affects the tablet hardness and disintegration time depends on the composition of the tablet. The Patent Office alleges that the tablet of Holderbaum would require having the same hardness as claimed because Holderbaum allegedly discloses identical or substantially identical composition as that set forth by Applicant and Fry. Applicant respectfully disagrees with the allegations by the Patent Office.

Contrary to allegations by the Patent Office, Fry does not remedy the deficiencies of Holderbaum as discussed above because Fry, like Holderbaum, fails to teach or suggest preparation of a compressed water-softening composition having the claimed composition and exhibiting the advantageous properties of high (but not overly high) level of hardness and a low level of friability as the present invention. Thus, Applicant submits that Holderbaum and Fry, taken singly or in combination, fail to teach or suggest a compressed water-softening composition comprising at least one water-softening active comprising sodium citrate which is present in an amount of at least 42% by weight of the composition and a blend of disintegrating agents comprising a cross linked polyplasdone, a water swellable cellulose and, optionally, a water soluble salt, wherein the compressed water-softening composition has hardness of at least 175N, as required by amended claim 1.

Because the features of independent claim 1 are neither taught nor suggested by Holderbaum and Fry, taken singly or in combination, these references cannot anticipate, and would not have rendered obvious, the features specifically defined in claim 1 and its dependent claims.

For at least these reasons, claims 1-19 are non-obvious in view of Holderbaum and Fry. Reconsideration and withdrawal of the rejections of the claims under 35 USC 103(a) are respectfully requested.

Should the Examiner in charge of this application believe that telephonic communication with the undersigned would meaningfully advance the prosecution of this application, they are invited to call the undersigned at their earliest convenience.

The early issuance of a *Notice of Allowability* is solicited.

PETITION FOR A ONE-MONTH EXTENSION OF TIME

Applicant respectfully petitions for a one-month extension of time in order to permit for the timely entry of this response. The Commissioner is hereby authorized to charge the fee to Deposit Account No. 14-1263 with respect to this petition.

CONDITIONAL AUTHORIZATION FOR FEES

Should any further fee be required by the Commissioner in order to permit the timely entry of this paper, the Commissioner is authorized to charge any such fee to Deposit Account No. 14-1263.

Respectfully Submitted;

Andrew N. Parfomak, Esq. — 11 June 2009 Date:

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CERTIFICATION OF TELEFAX TRANSMISSION:

I hereby certify that this paper is being telefax transmitted to the US Patent and Trademark Office to telefax number: 571 273-8300 on the date shown below:

Andrew N. Parfomak — Date: 11 June 2009

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